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UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF NEW YORK

A TO Z VAN WINGERDEN LLC, Plaintiff,		ECF Case
- v -		
DÜMMEN ORANGE, NA, INC., Defendant.		**COMPLAINT FOR PATENT INFRINGEMENT AND DEMAND FOR JURY TRIAL**

Plaintiff A TO Z VAN WINGERDEN LLC ("Plaintiff" or "AtoZ"), by and through its undersigned counsel, brings this complaint for Patent Infringement and Contributory Infringement against Defendant DÜMMEN ORANGE, NA, INC. ("Defendant" or "Dümmen"), and in support alleges as follows:

NATURE OF THE LAWSUIT

1. This is an action for patent infringement by Defendant of U.S. Pat. No. 7,946,078, invented by Alan Van Wingerden, entitled Starter Tray and Planting and Method of Using Tray on May 24, 2011 (the " '078 Patent" attached as **Exhibit A**) arising under the patent laws of the United States. *See.* 35 U.S.C. §§ et seq.

JURISDICTION AND VENUE

2. The United States District Court for the Eastern District of New York has original subject matter jurisdiction over the claims in this action pursuant to 28 U.S.C. Section 1331 (federal question) and 28 U.S.C. Section 1338 (patents and trademarks) based on the existence of an actual controversy between AtoZ and Dümmen for claims under the Patent Laws.

3. Venue is proper in for the Eastern District of New York pursuant to 28 U.S.C. § 1391(b) and (c) and 1400.

4. The Eastern District of the United States District Court for the District of New York has personal jurisdiction over Defendant, Dümmen, as Defendant operates, conducts and engages in, and carries on business in New York and has purposely availed itself of the laws, services and/or other benefits of the State of New York and therefore should reasonably anticipate being hailed into the Eastern District of New York.

THE PARTIES

5. AtoZ is a limited liability company organized under the laws of the State of New York, having a principal place of business at 721 Main Street, Farmingdale, New York 11735.

6. AtoZ has the rights to enforce the '078 Patent as per the assignment attached as **Exhibit B**.

7. Dümmen is a corporation organized under the laws of the State of California, having a principal place of business at 250 South High Street, Suite 650, Columbus, Ohio, 43215.

8. On information and belief, Dümmen is in the business of breeding and providing plants to the horticulture industry and conducts extensive business in this judicial district.

BACKGROUND

9. The inventor, Alan Van Wingerden, filed a patent application for Starter Tray and Planting and Method of Using a Tray March 19, 2007. The application was filed with a non-publication request. The application issued as U.S. Patent No. 7,946,078 on May 24, 2011. Mr.

Van Wingerden innovated a unique solution to provide a method of using multiple cuttings of the same or mixed species to be rooted together in order to simplify mixed combinations of inished plants for both the wholesaler and the home grower.

10. During the Ohio Short Course, a well-known trade show taking place in Columbus, Ohio, and where numerous individuals and companies in the horticulture industry come together, which took place from July 12-15, 2008, Alan Van Wingerden had a discussion with P. Wismans regarding his technology for his already filed patent application, which would issue as the '078 Patent. In addition, while talking with P. Wismans, Alan Van Wingerden showed P. Wismans a tray he was carrying in which the single tray was comprised of plants of multi or same species produced by combining multiple cuttings of multiple or the same species plants in a single tray and growing them together to produce a combination plant product. Alan Van Wingerden did not see any similar technology to his at the Dümmen booth nor at the Ohio Short Course.

11. A U.S. Provisional patent application, Provisional Application No. 61/080,528 was filed on July 14, 2008 for a Method of Preparing a Horticultural Display (the " '528 Application"). The sole inventor listed is Peter Theodorus Johannes Gerardus Wismans, known as P. Wismans, and believed to be an employee of Dümmen. An assignment dated November 4, 2008 from P. Wismans to Dümmen GmBH & Co. KG. was recorded with the United States Patent and Trademark Office ("USPTO") on April 25, 2011. A subsequent corrective assignment for the '528 Application dated February 19, 2011 from Dümmen GmBH & Co. KG. to Dümmen GmbH was recorded with the USPTO on February 19, 2011.

12. Dümmen filed a non-provisional application on November 6, 2008 claiming priority to the '528 Application. This non-provisional application eventually issued on February

22, 2011 as U.S. Patent No. 7,891,134 ("the '134 Patent"), a copy which is attached as **Exhibit C**. The sole inventor of the '134 Patent was listed as P. Wismans. An assignment dated November 4, 2008 from P. Wismans to Dümmen GmBH & Co. KG. was recorded with the USPTO on November 6, 2008. A corrective assignment was subsequently filed with the USPTO on February 21, 2011 to list Dümmen GmbH as the correct assignee. A final assignment was recorded with the USPTO on January 14, 2014 from Dümmen GmbH to Dümmen Group B.V.

13. The '134 Patent is the same technology of the '078 patent in that the tray shown to P. Wismans at the Ohio Short Course having the multiple cuttings of mixed plant species can be grown together in a single tray or cell to produce a multi-plant combination. The timing of the filing of the Dümmen application is suspect in light of the fact Mr. Van Wingerden showed the technology to P. Wismans prior to P. Wismans' filing.

14. Counsel for AtoZ sent a letter via FedEx on September 28, 2016 to P. Wismans of Dümmen requesting an opportunity to discuss the '078 Patent and the '134 Patent. A copy of the letter is attached as **Exhibit D**.

15. On October 19, 2016, counsel for Dümmen NA, Inc. responded in a letter via email to the September 28, 2016, stating that "....In the absence of further information as to each of your client's claims, we cannot comment on the allegations lodged against Dümmen in your letter, and consider this matter closed." A copy of the letter is attached as **Exhibit E**.

16. On November 16, 2016, a letter was sent via email by AtoZ's counsel to Dümmen's counsel responding to Dümmen's letter of October 19, 2016 and again, requesting an opportunity to discuss the '078 Patent and the '134 Patent. A copy of the letter is attached as **Exhibit F**.

17. On December 20, 2016, counsel for Dümmen NA, Inc. responded in a letter via email "….To that end, Dümmen will have representatives present at the Mid-Atlantic Nursery Trade Show (MANTS®) in Baltimore, on January 12, 2017, and they have proposed an in-person meeting between principals at this event to further discuss this matter. Please ask your client to contact Perry Wismans of Dümmen directly to arrange a mutually-agreeable time and location." A copy of the letter is attached as **Exhibit G**.

18. On December 23, 2016, a representative of AtoZ sent an email to P. Wismans requesting a meeting to discuss the '078 Patent and the '134 Patent at the MANTS show on January 12, 2017.

19. On December 23, 2016, P. Wismans replied to AtoZ's email of December 23, 2016, proposing meeting on January 12, 2017 at 9 AM at the MANTS show.

20. On January 12, 2017, representatives of AtoZ and P. Wismans met at the MANTS show to discuss the '078 Patent and the '134 Patent at the MANTS show on January 12, 2017. Per this meeting, P. Wismans told AtoZ that he believed the '078 Patent was more about the tray, and not the cuttings or plugs. P. Wismans further stated that he claimed his paperwork was in the patent office before he talked with Alan Van Wingerden and saw his tray and plant combination at the Ohio Short Course. No further meeting or telephone call was firmly discussed.

21. On February 9, 2017, Plaintiff sent a follow-up email to P. Wismans requesting further discussions from the MANTS meeting. P.Wismans did not respond to this email.

THE '078 PATENT

22. By assignment of the inventor and owner dated November 12, 2016, A to Z Van Wingerden and Associates, LLC ("AtoZ") is the owner of the '078 Patent.

23. The '078 Patent discloses a method of producing a plurality of plants of at least

one species that are planted in starter soil and contained in a starter tray. Prior to the filing date of the '078 Patent, a combination of multiple plant species produced from cuttings in a single tray or cell was not conducted.

24. Independent claim 1 of the '078 Patent claims the following:

> "A method employing a starter tray with a floor and one or more side walls extending from said floor in an outward direction, the method comprising the steps of: placing starter soil in said starter tray upon said floor and encompassed by said one or more side walls; planting a plurality of plants of at least one species in the starter soil; nurturing said plants in said starter tray long enough for said plants to develop entangled roots with an interplant root entanglement that at least partially consolidates the starter soil; dislodging as a unit in the outward direction relative to said floor and said side walls of said starter tray said starter soil with said entangled roots, said dislodging being performed before said plurality of plants have fully matured but after said entangled roots have reached the floor of the starter tray and have consolidated the starter soil to allow dislodging by a single person without crumbling of said starter soil and said entangled roots; and transplanting said starter soil with said entangled roots by lowering as a unit down into a transplant site without the starter tray."

An example of the method from the '078 Patent can be found in Figure 8 on the cover page of the '078 Patent.

25. No later than September 15, 2011, Dümmen was aware of the '078 Patent, as Dümmen's counsel submitted the '078 Patent in an Information Disclosure Statement during the prosecution of U.S. Patent No. 8,136,294, which claims priority to the '134 Patent.

FIRST CAUSE OF ACTION
DIRECT INFRINGEMENT OF '078 PATENT
(35 U.S.C. § 271)

26. AtoZ incorporates by reference all preceding paragraphs as though fully set forth herein.

27. AtoZ has neither authorized Dümmen to make or sell any products that utilize the '078 patent nor has AtoZ given Dümmen a license to the AtoZ patent.

28. The '078 patent remains valid, enforceable and unexpired.

29. Based on the facts provided in this Complaint regarding the Ohio Short Course and as part of its Information Disclosure Statement, Dümmen had actual or constructive knowledge of the '078 patent.

30. Upon information and belief, Dümmen has directly infringed and continues to infringe at least claim 1 of the '078 Patent by making or selling within the United States or importing into the United States plant combinations marketed as at least CONFETTI GARDEN which is listed as **Exhibits H-I** in violation of 35 U.S.C. §271(a). Exhibit H show that the plants are "Nurtured with care from special cuttings, 'Confetti Garden' mixes of two or three different plants grow into a spectacular single planting." Exhibit I shows multiple species of unrooted cuttings as step one, to be grown together as a single "Confetti liner" with the plants containing entangled roots as shown step 2, and transplanted into a larger container to be grown as a multi-species and plant combination.

31. The commercial sale of infringing CONFETTI GARDEN combinations within the United States has caused and will cause economic damage to AtoZ including lost sales and lost royalties.

32. Dümmen has infringed and continues to infringe the '078 patent, including without limitation, by making, offering for sale and selling the CONFETTI GARDEN and other products without license permission or authorization from AtoZ.

32. The activities of Dümmen as set forth in this Count have been to the injury, detriment and irreparable harm of AtoZ in the past and continuing in the future.

SECOND CAUSE OF ACTION
ACTIVE INDUCEMENT OF INFRINGEMENT OF '078 PATENT
(35 U.S.C. § 271(b))

33. AtoZ incorporates by reference all preceding paragraphs as though fully set forth herein.

34. Upon information and belief, one or more of Dümmen's growers, distributors, suppliers, retailers, customers, or licensees directly infringe and continue to infringe at least claim 1 of the '078 Patent by making, using, selling, offering for sale, or importing into the United States plant combinations marketed as at least CONFETTI GARDEN.

35. Exhibit E shows a "growing guide" for CONFETTI GARDEN products taken from Dümmen's website which shows that Dümmen has knowingly and intentionally induced the direct infringement of its growers, distributors, suppliers, retailers, customers, or licensees by providing growing tips and guides for CONFETTI GARDEN products.

36. Dümmen is aware of the '078 Patent and knew that the acts of its growers, distributors, suppliers, retailers, customers, or licensees of CONFETTI GARDEN products, if taken, would constitute infringement of the '078 Patent.

37. The infringement of the '078 Patent by Dümmen's growers, distributors, suppliers, retailers, customers, and licensees has caused continuing economic damage to AtoZ, including lost profits and lost royalties.

THIRD CAUSE OF ACTION
CONTRIBUTORY INFRINGEMENT OF '078 PATENT
(35 U.S.C. § 271(c))

38. AtoZ incorporates by reference all preceding paragraphs as though fully set forth herein.

39. Dümmen sold or caused to be sold in the United States or imported or caused to be imported into the United States plants or plant parts suitable for use in CONFETTI GARDEN products knowing the same to be specifically made for use in infringing at least claim 1 of the '078 Patent.

40. Upon information and belief, using plants or parts of plants sold or imported by Dümmen, one or more of Dümmen's growers, distributors, suppliers, retailers, customers, or licensees have directly infringed at least claim 1 of the '078 Patent by making, using, selling, or offering for sale in the United States CONFETTI GARDEN products.

41. Dümmen's actions constitute contributory patent infringement under 35 U.S.C. §271(c).

36. Dümmen's contribution to the direct infringement of the '078 Patent has caused and will continue to cause economic damage to AtoZ, including lost profits and lost royalties.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff, AtoZ, demands judgment, prays for relief against Defendant, and respectfully requests that the Court:

A. Enter a finding of infringement against Defendant under the '078 patent.;

B. Award in favor of Plaintiff and against Defendant as Plaintiff hay have suffered, but in no event less than a reasonable royalty pursuant to 35 U.S.C. §285;

C. Award in favor of Plaintiff and against Defendant an enhancement of damages;

D. Find that this is an exceptional case;

E. Enter an injunction permanently enjoining infringement;

F. Award Plaintiff its attorneys' fees against Defendant under 35 U.S.C. §285;

G. Award Plaintiff its costs against Defendant; and

H. Award in favor of Plaintiff and against Defendant such other further relief as is just, fair or equitable.

DEMAND FOR TRIAL BY JURY

Plaintiff demands a trial by jury on all claims so triable.

WILSON ELSER MOSKOWITZ EDELMAN
& DICKER LLP

DATED: April 4, 2017

By: ______________________
Jura Zibas
Attorneys for Plaintiff
A TO Z VAN WINGERDEN LLC